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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,397	07/10/2001	Peilin Chou	30013600-0003	9023

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/902,397

**Applicant(s)**

CHOU, PEILIN

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 depends on method claim 1, but does not add steps to claim 1.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-9, 13-16, 20-23, 25-27 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bezos et al. (US006029141A).
6. Bezos et al. teaches (independent claims 1, 13, 20, 21, 25 and 29) a method, storage medium and apparatus for providing an advertisement for a product or service on a personal electronic document/personal web page accessible over a data network (the *Internet*, col. 1

line 7), the method comprising: providing, by a carrier (*the merchant*, col. 1 line 33), the product or service; providing, by the carrier, a document design application (*detailed information about setting up an associate's Web site*) to the user (*the associate*, col. 1 lines 50-55 and col. 10 lines 52-55); receiving over the data network, by a server in communication the data network (*Web server 116*), the personal electronic document/personal web page (*catalog documents 120*), the personal electronic document constructed using the document design application, the personal electronic document/personal web page associated with the user/associate (col. 6 line 59 to col. 7 line 5); storing the personal electronic document/personal web page/*catalog documents 120* as data on a storage medium (labeled **120** in Fig. 1) in communication with the data network; inserting, in the personal electronic document/personal web page/*catalog documents 120* advertisement information provided by the carrier (the icon **600** in Fig. 6, col. 11 lines 43-50); and providing access over the data network to the personal electronic document/personal web page/*catalog documents 120* stored on the storage medium by a second computer (*customer computer 108*) in communication the data network, the second computer associated with a visitor/*customer* of the personal electronic document/personal web page/*catalog documents 120* (col. 6 lines 1-9 and col. 11 lines 28-40).

7. Bezos et al. does not explicitly teach that the product or service is provided to a user/associate. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the merchant sells goods to anyone, which necessarily includes the user/associate. Alternatively, because the user/associate is regarded as a reliable source of product information (col. 1 lines 28-30) and has an established reputation in the product field (col. 3 lines 26-30), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bezos et al. that the product be bought by, and therefore provided to a user/associate.
8. Bezos et al. does not explicitly teach a first computer by which the personal electronic document/personal web page/*catalog documents 120* are sent to a server in communication the data network/*Web server 116*. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence

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tending to show inherency, it is noted that said *catalog documents 120* have to be sent from somewhere, by the user/associate (col. 6 line 67 to col. 1 line 1). Said "first computer" is whatever computer used by the associate for this purpose (e.g., *associate computer 200*, col. 9 lines 54-56).

9. For claim 20, the registration of an associate following purchase of a product reads on "a second part of the purchase of the product".
10. Bezos et al. also teaches at the citations given above claims 2-4, 6, 22, 23, 26, 27, 30 and 31.
11. Bezos et al. also teaches: claims 7 and 14 (col. 10 lines 10-15); claims 8 and 15 (col. 6 lines 27-30); and claims 9 and 16 (col. 16, lines 20-32), because the user/associate is also a visitor/customer.
12. Claims 10-12 and 17-19 are rejected under 35 U.S.C. 103(a) as obvious over Bezos et al. (US006029141A). Bezos et al. does not teach that demographic data includes age, gender and income. Official notice is taken (MPEP § 2144.03) that these were common elements of demographic data, at the time of the instant invention. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bezos et al. that the demographic data include age, gender and income data.
13. Claims 5, 24 and 28 are rejected under 35 U.S.C. 103(a) as obvious over Bezos et al. in view of Horstmann (US006363356B1). Bezos et al. does not teach sending the product as an electronic signal (i.e., that the product is downloadable). Horstmann teaches sending the product as an electronic signal/a downloadable product (col. 1 lines 28-32). Because Horstmann teaches that it is obvious to add downloadable products to the referral system of Amazon.com (col. 1 lines 10-32), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Horstmann to those of Bezos et al.

### **Conclusion**

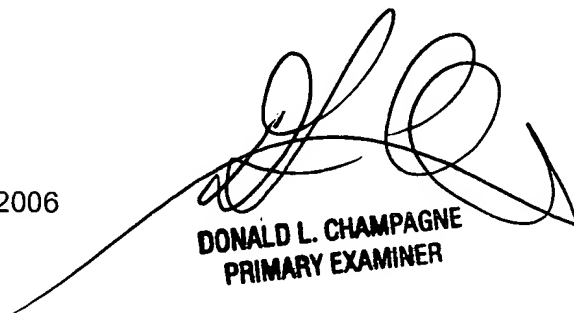
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal*

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fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

15 June 2006



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622